

Response under 37 C.F.R. 1.116
- Expedited Examining Procedure -
Examining Group 1794

MAIL STOP AF

87038/AJA

Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Inventor(s):
Stephanie V. Desrousseaux, et al.

Group Art Unit: 1794
Examiner: Betelhem Shewareged

INKJET RECORDING
ELEMENT

Confirmation No. 3199

Serial No.: 10/583,528

Filed: June 16, 2006

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection in the above identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested based on the following arguments.

ARGUMENTS

Claims 1-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al. (EP 1 184 193) in view of Poncelet et al. (US 5,888,711) and Plank et al. (US 3,816,342). The rejection represents clear error, as the Examiner has based such proposed rejection on clearly erroneous interpretations of the teachings of the applied art, and as a prima facie case of obviousness has accordingly not been established.

In paragraph 5 of the Final Rejection, the Examiner argues that "Campbell and Poncelet are analogous art because they [are] from similar problem solving area in relation to polymeric aluminosilicate material", and that it would have been obvious to combine the aluminosilicate polymeric material of Poncelet with the invention of Campbell with the motivation to do

so being “as Poncelet suggests, providing a permeable and antistatic coating layer (col. 2, line 15).” Such position represents clear error, as rather than be from a “problem solving area in relation to polymeric aluminosilicate material”, Campbell does not in any way relate to polymeric aluminosilicate material. To the contrary, as acknowledged by the Examiner in paragraph 4 of the Final Rejection, Campbell does not teach use of particles comprising an aluminosilicate. Further, the proposed motivation for the combination is based on a misinterpretation of the actual teaching of Poncelet, as Poncelet does not teach a “permeable and antistatic coating layer” at col. 2, line 15, but rather antistatic coatings or permeable membranes. The “membranes” are apparently envisioned for use as a coherent film as mentioned at col. 1, lines 22-24, while the antistatic coatings are intended for use in forming antistatic layers for elements such as photographic elements as mentioned at col. 2, lines 23-27. The Examiner does not provide any rational as to why it would have been suggested based on the distinct and non-related teachings of such references to employ the antistatic layer or coherent film membrane materials of Poncelet (where such coatings do not contain a binder as acknowledged by the Examiner) in an ink-receiving layer of an inkjet recording element such as taught by Campbell. Further to this point, the antistatic layers of Poncelet have very thin coverage (e.g., only 30 mg of inorganic polymer per m² as referenced at col. 5, line 66 and Coverage indicated in Table 1 in col. 7), which coverage would provide too thin a layer (by multiple orders of magnitude) to be effective at providing an ink-receiving layer of an inkjet recording layer. The references are clearly directed towards distinct fields, and there is no suggestion at all to employ the antistatic materials of Poncelet in the image-receiving layer of the inkjet recording element of Campbell. Clearly, such suggestion is rather proposed only through the impermissible use of hindsight reconstruction based on Applicant’s own teachings, and a prima facie case of obviousness to combine such references has not been established.

The Examiner acknowledges that the proposed combination of Campbell and Poncelet is insufficient to teach the present claimed invention as Poncelet does not teach use of a chelating agent in preparing the aluminosilicate, and thus further relies upon Plank et al for such teaching,

arguing that it would have been obvious to combine the chelating agent of Plank with the invention of Poncelet, with the motivation being “as Plank suggests, improving the attrition resistance of the product (col. 19, line 37).” Such “attrition resistance,” however, is a property specifically taught by Plank in such referenced paragraph as a property desired for fluid catalysts prepared from slurries of clay and aluminosilicate, and is not taught as having any relevance outside of such specific use, and in particular to the antistatic materials of Poncelet or the inkjet recording element of Campbell. As further explained in the paragraph bridging columns 8 and 9 of Plank, resistance to attrition is an important characteristic of fluid catalyst particles in order to reduce the need for replacement of particles in a fluid catalyst system, as such particles have a tendency to break down during fluidization. As there is no fluidization in the antistatic layer taught by Poncelet, or the image-receiving layer of Campbell, there is clearly no teaching or suggestion to combine such teachings for the reasons alleged by the Examiner, and certainly not to combine such teachings for use in an ink-receiving layer in accordance with the present claimed invention. Again, the Examiner has proposed a combination of references only through the impermissible use of hindsight reconstruction based on Applicant’s own teachings, and a prima facie case of obviousness of the present claimed invention has clearly not been established.

While a prima facie case of obviousness as to combining the applied reference has not been established, Applicants have further explained that the claimed invention in any event would still not result from such proposed combination, as the present claimed invention is directed towards an inkjet recording element that contains an aluminosilicate polymer obtainable by a specific method which provides an amorphous material, while the higher temperatures of Poncelet provide a crystalline material. In the “Response to Arguments” section of the Final Rejection, the Examiner states that the claimed invention is “directed to an ink jet recording element containing aluminosilicate polymer” and that the “combination of Campbell and Poncelet also teaches an ink jet recording element containing polymeric aluminosilicate”, and that even if the aluminosilicate of Poncelet is crystalline, “there is nothing that shows in the current invention that the molecular

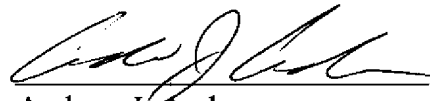
arrangement of the aluminosilicate is critical to the claimed ink jet recording element.” Such arguments, however, do not in any way establish a prima facie case of obviousness with respect to use of an aluminosilicate polymer obtained by the specified process in accordance with the further claim requirements, as none of such references teach or suggest use of such specified aluminosilicate polymer in any fashion.

The Examiner’s arguments further clearly do not establish a prima facie case of obviousness as the claimed invention is not simply “directed to an ink jet recording element containing aluminosilicate polymer”, but rather more specifically directed towards an ink jet recording element comprising an ink-receiving layer comprising an aluminosilicate polymer obtainable by the specified process. While the combination of Campbell and Poncelet might be argued to teach an inkjet recording element comprising an image-receiving layer as taught by Campbell in combination with a separate antistatic layer as taught by Poncelet, it does not teach or suggest an ink-receiving layer as claimed. The present specification further does demonstrate that the claimed invention requirement of employing at least one chelating agent of aluminum to the aluminosilicate polymer (obtained by the specified process) at a molar ratio of chelating functions of the chelating agent and the aluminum of the aluminosilicate polymer of greater than or equal to 1 is critical to obtaining the desired features of the present claimed invention. In particular, as stated at page 10, lines 14-24, it is demonstrated that in the presence of an aluminosilicate polymer/chelating agent/hydrosoluble binder ternary system, when the molar ratio between the chelating functions of the chelating agent and the aluminum of the aluminosilicate polymer is greater than or equal to 1, it forms in the ink-receiving layer aggregates enabling the porosity of the layer, and thus the ink drying speed, to be increased. When the molar ratio is less than 1, as for the aluminosilicate polymer employed in comparison Ex. 5 (prepared by Synthesis No. 6), aggregates are not formed upon drying of the layer (page 18, lines 30-31), resulting in substantially longer ink drying time (page 20, lines 5-28 and Fig. 4). As none of the cited references teach use of any required amount of chelating agent in such required combination of components in order to obtain such desired

performance (to the contrary, cited Plank only teaches the use of a “small amount” of a chelating agent to remove alumina from the clay structure), the present claimed invention is clearly not taught or suggested by such applied references.

In view of the above, it follows that the Examiner has clearly not established a *prima facie* case of obvious of the subject matter of the claims relative to the teaching of the applied references. Rather, the rejections of the claims are clearly in error, and withdrawal of such rejections is courteously solicited.

Respectfully submitted,



Andrew J. Anderson
Attorney for Applicant(s)
Registration No. 33,564

Andrew J. Anderson:clb
Rochester, NY 14650
Telephone: (585) 722-9662
Facsimile: (585) 477-1148

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.